

**REMARKS**

Claims 1, 2, 5, 6, 9, 10, and 31-51 were pending to this claim. Applicant has cancelled claims 1, 2, 5, 6, 10, and 31-32 without prejudice, leaving claims 9 and 33-49. Applicant believes the presently amended claims place the application in a condition for allowance, and respectfully requests the Examiner to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

**REJECTION UNDER 35 U.S.C. § 103**

Claims 1-2, 5, 6 and 31-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leupold. This rejection is respectfully traversed.

The Final Office Action states on page 4 that Leupold discloses a magnet that adjusts or tunes magnitude and direction of an internal field 51, which is achieved by rotating magnet cylinders 35 and 36. (Column 3 line 42). The varying magnetization directions in magnets 35 and 36 (and magnet 11 in Fig.1) control an internal field 51 (15) within the magnet's internal volume.

With regard to independent claims 33 and 41, these claims have been amended to clarify that the permanent magnet is comprised of a plurality of permanent magnet segments, the magnetization direction of each permanent magnet segment varying with respect to each segment's assembled location so that the magnetization direction of each permanent magnet segment is in the direction that substantially optimizes the strength of the externally projecting magnetic field at the selected point. Leupold doesn't disclose magnet segments that are assembled/fixed, and do not rotate. Unlike Leupold, the magnetization direction of each segment is in a direction that optimizes the strength of an externally projected magnetic field at a selected point, rather than an internal field.

During a February 22, 2005 telephone conversation between the Examiner and Applicant's patent agent Kevin Pumm (Reg. No. 49,046), the Examiner indicated that the above claim amendments would patentably distinguish these claims over Leupold. As such, Applicant believes that claims 33 and 41 are in a condition for allowance.

With regard to claims 34-40, these claims ultimately depend from independent claim 33, which Applicant believes to be allowable in view of the above remarks. As such, Applicant believes that claims 34-40 are also allowable for at least these reasons.

With regard to claims 42-48, these claims ultimately depend from independent claim 33, which Applicant believes to be allowable in view of the above remarks. As such, Applicant believes that claims 42-48 are also allowable for at least these reasons.

Applicant has cancelled claims 1 through 8, 10 and 31 through 32 without prejudice.

Claims 9-10 and 31-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manwaring et al. in view of Leupold. This rejection is respectfully traversed.

The Final Office Action states that Manwaring discloses projecting a magnetic field into a patient except for the magnet assembly being a permanent magnet, and that Leupold discloses a permanent magnet in which the magnetization direction varies to optimize a field. However, Leupold discloses a field within the volume of the magnet, and does not disclose optimizing the field strength of an externally projected magnetic field at a selected point external to the magnet.

With regard to claim 9, this claim has been amended to clarify that the magnet for projecting a magnetic field into a patient comprises a plurality of permanent magnet segments, the magnetization direction of each permanent magnet segment varying with respect to each segment's assembled location so that the magnetization direction of each permanent magnet segment is in the direction that substantially optimizes the strength of the externally projected magnetic field at a selected point. Unlike Leupold which projects an internal field within the volume of the magnet, the projection of the magnetic field into the patient recited in claim 9 implies that the magnetic field is inherently externally projected from the magnet as shown in Fig. 2. The magnet in amended claim 9 optimizes the field strength of an externally projected magnetic field at a selected point a given distance from the magnet. This allows a smaller lighter magnet to be used for externally projecting a magnetic field into a patient that is optimized at a selected point which is a minimal distance from the magnet, such that the magnet may be positioned near the patient to control a magnet medical element in a patient. As such, Applicants believe that claim 9 patentable over Manwaring, and is allowable.

### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt

and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

Dated: 2-22-05

By: BK Wheelock  
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## Applicant Initiated Interview Request Form

Application No.: 10/082,715 First Named Applicant: Creighton et al.  
 Examiner: Lincoln Donovan Art Unit: 2832 Status of Application: Final Office Action

## Tentative Participants:

(1) Kevin Pumm - 49,046 (2) \_\_\_\_\_  
 (3) \_\_\_\_\_ (4) \_\_\_\_\_

Proposed Date of Interview: 2-22-05 Proposed Time: \_\_\_\_\_ (AM  PM )

## Type of Interview Requested:

(1)  Telephonic (2)  Personal (3)  Video Conference

Exhibit To Be Shown or Demonstrated:  YES  NO

If yes, provide brief description: \_\_\_\_\_

## Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>rej</u>	<u>claim 33</u>	_____	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
(2) <u>rei</u>	<u>claim 41</u>	_____	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
(3) <u>rej</u>	<u>claim 9</u>	_____	<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Continuation Sheet Attached

## Brief Description of Arguments to be Presented:

Applicant proposed amendment that the magnet comprise a plurality of permanent magnet segments, the magnetization direction of each segment varying with respect to each segment's assembled location so that the direction substantially optimizes the strength of the externally projected magnetic field at a selected point, which distinguished the claims over Leupold

An interview was conducted on the above-identified application on 2-22-05

## NOTE:

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

SD Wehrle  
(Applicant/Applicant's Representative Signature)

(Examiner/SPE Signature)

This collection of information is required by 37 CFR 1.133. The information is required to obtain, or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.